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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/736,374

12/15/2000

Masatoshi Arai

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7590

11/28/2007

STAAS & HALSEY LLP

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EXAMINER

CAMPEN, KELLY SCAGGS

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

11/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/736,374

Applicant(s)

ARAI ET AL.

Examiner

Kelly Campen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/27/06, 4/6/07
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

The prior office action dated 4/21/2006 has been withdrawn and is replaced with the instant Office Action.

Specification

It is maintained that the abstract of the disclosure is objected to because it includes improper idiomatic English, for example "system using auction has" in line 1. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because it is replete with idiomatic English.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of

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the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Examples [emphasis added] of improper idiomatic English include: page 3, lines 2-7 “...an advertisement tenant bidding part for allowing a sponsor to bid for an advertisement tenant contained in the disclosed contents; a sponsor determining part for knocking down the advertisement tenant to the sponsor that has bid a highest price; a contents creating part for correcting the advertisement tenant contained in the contents in accordance with requests from the sponsor...” and page 3, lines 16-17 “...digital contents advertisement display system using auction according to the present invention...” and page 3, lines 28-32 “...the digital contents advertisement display system using auction according to the present invention further includes an advertisement tenant attention degree control part for changing a display of the advertisement tenant so that a degree of attention to the advertisement tenant in the contents is changed in accordance...” and page 6 lines 1-4 “...a character in the present embodiment refers to an idea

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including general things, and includes an artificial creature and the like that are artificially created, as well as a car, a TV and other things...” and page 7 lines 2-4 “...an advertisement tenant refers to a billboard shown in the outline of contents, articles such as a car and a magazine used in the contents, or a character used in the contents...” are examples, not intended to be a complete listing of all occurrences of the idiomatic English recitations. **Applicant repeatedly refers to language not known or used in the art of Advertising.**

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

While the interview of May 19, 2006 stated the 112 rejections were in error, upon reconsideration, the rejections are deemed to be proper as follows:

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement as applied in the prior office action. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, claims 1-15 do not enable one of ordinary skill in the art to use the invention as it is not enabled for an “advertising tenant” while page 6 defines the “tenant” the definition is vague at best. The advertising medium is not enabling for “a car” as indicated in the specification on page 6. These citations are merely examples of several issues.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “advertisement tenant” in claims 1-15 is used by the claim to mean “a billboard shown in the outline of contents, articles such as a car and a magazine used in the contents, or a character used in the contents.” while the accepted meaning is “Advertisement is defined as a notice to attract public attention or patronage while tenant is defined as an occupant, inhabitant, or dweller in a place.” The term is indefinite because the specification does not clearly redefine the term.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as applied in the prior office action. See prior office action for specific reasoning.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Further *examples* include “using auction” this should read --using an auction-- and “a winner sponsor” should read --a winning sponsor--.

Claim Rejections - 35 USC § 102

For examination purposes, the art is being as best can be applied in view of the extensive 112 1st and 2nd paragraph rejections as applied above.

Upon reconsideration, following the interview held on May 19, 2006, the USC 35 USC 102 (b) rejection is reinstated as follows:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuasa et al. (JP 11(1999)-95694A) as applied in the prior office action, see prior office action for specific citations and reasoning.

Response to Arguments

Examiner acknowledges applicants claim for foreign priority to Application No. 2000/198544 Japan, filed 30 June 2000. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicant's arguments filed 9/28/05 have been fully considered but they are not persuasive.

With regards to Applicant's arguments against the 35 USC 112 rejections and the requirement for a new specification, applicant is directed to the above explanation in the instant Office Action.

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Examiner acknowledges applicant's response to the 35 USC 105 Request.

In response to applicant's argument against the requirement for a new specification, applicant is referred to the above specific examples within the specification to show cause for a substitute specification. In addition, Examiner is also making a 35 USC 105 request for information (see attached).

With regards to applicant's arguments against the 35 USC 112 second paragraph rejection, it is unclear how applicant differentiates this argument from the 35 USC 101 arguments. Examiner has addressed the 35 USC 112 second paragraph rejection in the above rejections.

With regards to Applicant's arguments against the Yuasa et al. reference, applicant argues Yuasa et al. do not discuss any auctioning process, Yuasa et al. cannot anticipate the claimed present invention. Examiner disagrees. The scope of the Yuasa et al. reference encompasses the limitations of the instant claimed invention.

Conclusion

Examiner's Note

Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially

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teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (571) 272-6740. The examiner can normally be reached on Monday-Thursday.

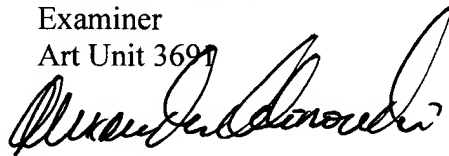
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ksc

/Kelly S. Campen/
Examiner
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ALEXANDER KALINOWSKI
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